

REMARKS

Reconsideration of the present application and entry of this amendment are respectfully requested. Claims 1 to 44 are currently pending, claims 36 and 38 to 44 have been canceled, and claim 14 has been amended.

The Office Action mailed May 27, 2004 addressed claims 1 to 44. Claims 1 to 44 were rejected.

Claims 38 and 44 were rejected under 35 U.S.C. § 102(b) as being anticipated by Sullivan et al. (5,356,941). The Examiner stated that regarding claim 38, Sullivan discloses a process for making a ball comprising a core and cover, wherein the cover is made using a RIM technique by injection of liquid urethane, and regarding claim 44, Sullivan discloses a golf ball comprising a urethane cover.

Although Applicants continue to respectfully disagree with the Examiner, claims 38 and 44 have been canceled by this Amendment. Applicants therefore respectfully request that the Examiner reconsider and withdraw the rejections of claims 38 and 44 as anticipated by Sullivan et al. under 35 U.S.C. § 102(b).

Claims 42 to 44 were rejected under 35 U.S.C. § 102(b) as being anticipated by Cavallaro (5,759,676). The Examiner stated that Cavallaro discloses a golf ball comprising a core and a polyurethane cover, wherein the cover has a flex modulus greater than 80,000 psi and a thickness from 0.015 to 0.14 inch. The Examiner concluded that the reaction time and recycled reactants are process/method steps and are not relevant to the final product.

Although Applicants continue to respectfully disagree with the Examiner, claims 42 to 44 have been canceled by this Amendment. Applicants therefore respectfully request that the Examiner reconsider and withdraw the rejections of claims 42 to 44 as anticipated by Cavallaro under 35 U.S.C. § 102(b).

Claims 14 to 20, 23, 29 to 34, 37 and 40 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Wu (5,334,673) in view of Sullivan (5,356,941). The Examiner stated that regarding claim 14, Wu discloses polyurethane golf ball parts, but Wu does not disclose reaction injection molding. The Examiner further stated that Sullivan teaches a game ball comprising a cover formed by RIM. Claims 15 to 20, 23, 29

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to 34, 37 and 40 were variously rejected over Wu and Sullivan. The Examiner concluded that one of ordinary skill in the art would have modified Wu in view of Sullivan by using a RIM process to achieve the desired properties.

Although Applicants continue to respectfully disagree and submit that the Examiner had not made out a *prima facie* case of obviousness, in an effort to hasten prosecution, claim 14 has been amended to incorporate the limitation of claim 36, which was not rejected over prior art. Applicants respectfully submit that claim 14, as amended, is allowable. Claims 15 to 20, 23, 29 to 34, 37 and 40 depend, or ultimately depend, from amended claim 14, and are therefore also allowable.

For at least these reasons, Applicants respectfully submit that claims 14 to 20, 23, 29 to 34, 37 and 40 are not obvious over Wu in view of Sullivan. Applicants therefore respectfully request that the Examiner reconsider and withdraw the rejection of claims 14 to 20, 23, 29 to 34, 37 and 40 under 35 U.S.C. § 103(a) as obvious over Wu in view of Sullivan.

Claim 35 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Wu (5,334,673) in view of Sullivan (5,356,941) and Molitor (4,674,751). The Examiner stated that Wu in view of Sullivan does not disclose an ionomer blended with the polyurethane in the cover material, but Molitor teaches a cover made from a urethane and an ionomer. The Examiner concluded that one of ordinary skill in the art would have modified the cover by using an ionomer to improve the durability of the cover.

Although Applicants continue to respectfully disagree and submit that the Examiner had not made out a *prima facie* case of obviousness, in an effort to hasten prosecution, claim 14 has been amended to incorporate the limitation of claim 36, which was not rejected over prior art, as previously discussed. Applicants respectfully submit that claim 14, as amended, is allowable. Claim 35 depends from amended claim 14 and is therefore also allowable.

For at least these reasons, Applicants respectfully submit that claim 35 is not obvious over Wu in view of Sullivan and Molitor. Applicants therefore respectfully request that the Examiner reconsider and withdraw the rejection of claim 35 under 35 U.S.C. § 103(a) as obvious over Wu in view of Sullivan and Molitor.

Claims 39 and 41 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Wu (5,334,673) in view of Sullivan (5,356,941) and "Bayer – RIM Part and Mold Design". The Examiner stated that Bayer teaches the use of glycolysis, a new way to convert polyurethane materials back to their original raw materials. The Examiner concluded that skilled in the art would have modified the invention of Wu in view of Sullivan by adding recycled material to decrease manufacturing costs.

Although Applicants continue to respectfully disagree and submit that the Examiner had not made out a *prima facie* case of obviousness, in an effort to hasten prosecution, claim 14 has been amended to incorporate the limitation of claim 36, which was not rejected over prior art, as previously discussed. Applicants respectfully submit that claim 14, as amended, is allowable. Claims 39 and 41 depend from amended claim 14 and are therefore also allowable.

For at least these reasons, Applicants respectfully submit that claims 39 and 41 are not obvious over Wu in view of Sullivan and "Bayer – RIM Part and Mold Design". Applicants therefore respectfully request that the Examiner reconsider and withdraw the rejection of claims 39 and 41 under 35 U.S.C. § 103(a) as obvious over Wu in view of Sullivan and "Bayer – RIM Part and Mold Design".

Claims 14, 18, 21, 22 and 24 to 28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Cavallaro (5,759,676) in view of Sullivan (5,356,941). The Examiner stated that regarding claims 14 and 18, Cavallaro discloses a golf ball comprising a core and a polyurethane cover, but Cavallaro does not disclose reaction injection molding. The Examiner further stated that Sullivan teaches a game ball comprising a cover formed by RIM. Claims 18, 21, 22 and 24 to 28 were variously rejected over Cavallaro and Sullivan. The Examiner concluded that one of ordinary skill in the art would have modified Cavallaro in view of Sullivan by using the RIM process to achieve the desired properties.

Although Applicants continue to respectfully disagree and submit that the Examiner had not made out a *prima facie* case of obviousness, in an effort to hasten prosecution, claim 14 has been amended to incorporate the limitation of claim 36, which was not rejected over prior art. Applicants respectfully submit that claim 14, as amended,

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is allowable. Claims 18, 21, 22 and 24 to 28 depend, or ultimately depend, from amended claim 14, and are therefore also allowable.

For at least these reasons, Applicants respectfully submit that claims 14, 18, 21, 22 and 24 to 28 are not obvious over Cavallaro in view of Sullivan. Applicants therefore respectfully request that the Examiner reconsider and withdraw the rejection of claims 14, 18, 21, 22 and 24 to 28 under 35 U.S.C. § 103(a) as obvious over Cavallaro in view of Sullivan.

Claims 38 to 41 and 44 were provisionally rejected under 35 U.S.C. § 101 as claiming the same invention as that of claims 40, 41, 43, 44 and 48 of copending Application No. 09/877,600.

Applicants respectfully submit that claims 38 to 41 and 44 have been canceled by this Amendment. Applicants respectfully submit that this overcomes the rejection and request that the Examiner reconsider and withdraw the rejection under 35 U.S.C. § 101.

Claims 1 to 37, 42 and 43 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 4, 9 to 11, 13, 14, 16 to 39, 46 and 47 of copending Application No. 09/877,600.

Although Applicants respectfully disagree with the Examiner, in an effort to hasten prosecution, Applicants herein submit a Terminal Disclaimer which disclaims the terminal portion of any patent granting from the instant applications, as required under MPEP § 1490. Applicants respectfully submit that this overcomes the rejection.

The Examiner is invited to telephone Applicants' attorney if it is deemed that a telephone conversation will hasten prosecution of the application.

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**CONCLUSION**

Applicants respectfully request reconsideration and allowance of each of the presently rejected claims, claims 1 to 44. Applicants respectfully request allowance of claims 1 to 35 and 37, the claims currently pending in the present application.

Respectfully submitted,

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Date: July 27, 2004

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